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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/405,299	09/23/1999	RANDALL S. ALBERTE	CEA-005.01	9329

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EXAMINER
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YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/405,299

Applicant(s)

ALBERTE ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

1774

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 08 November 2004. Appellant's Brief must be filed within the period set forth in 37 CFR ~~1.192(a)~~ <sup>41.37(a)(1)</sup>, or any extension thereof (37 CFR ~~1.191(d)~~ <sup>41.37(e)</sup>), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 71-73 and 75-78.

Claim(s) withdrawn from consideration: 34-58, 65-70, 74 and 79-103.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE:

Entry of the proposed amendment requires further consideration under 35 U.S.C. 112, 1<sup>st</sup> par., and probably will require modification of the rejection under 35 U.S.C. 112, first paragraph, to address the altered claim limitations. Upon entry of the proposed amendment, the examiner is presently inclined to maintain a rejection under 35 U.S.C. 112, 1<sup>st</sup> par., absent persuasive arguments to the contrary. Even though the proposed amendment narrows the scope of the finally rejected claims, the claims remain quite broad compared to the enabling scope of the disclosure given that the claims are not drawn to a compound per se, but to a coating for a plant surface comprising an effective amount of an anti-fouling compound. In considering scope of enablement, the scope of "coating", "plant surface", "effective amount" and "anti-fouling" are all taken into consideration.

If applicant persuades the examiner that the proposed amended claims comply with 35 U.S.C. 112, 1<sup>st</sup> paragraph, further consideration may be required with respect to some or all of the currently withdrawn claims.

Continuation of 3. Applicant's reply has overcome the following rejection(s):

The terminal disclaimer filed on November 08, 2004, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application No. 09/405,269 has been reviewed and is accepted. The terminal disclaimer has been recorded. Accordingly, the provisional obviousness-type double patenting rejection is overcome.

Continuation of 5. does NOT place the application in condition for allowance because:

The proposed amendment will not be entered for reasons noted above, and the claims stand rejected for reasons of record.



MARIE YAMNITZKY  
PRIMARY EXAMINER

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